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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HYUN-JEONG KIM

Appeal 2009-006240
Application 09/734,852
Technology Center 2600

Decided: December 1, 2009

Before KENNETH W. HAIRSTON, MARC S. HOFF, and
BRADLEY W. BAUMEISTER, *Administrative Patent Judges*.

BAUMEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 16-27. Claims 1-15 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b). Oral argument was held on November 17, 2009.

We AFFIRM-IN-PART.

Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter a new ground of rejection under 35 U.S.C. § 103.

Appellant's invention relates to:

a method of notifying a caller of confirmation of a voice or text message in a wireless communication system. A calling mobile station transmits a voice or text message to a called mobile station. If the called mobile station senses confirmation of the received voice or text message, it notifies a calling mobile station of the message confirmation via a confirmation message. Upon receipt of the confirmation message, the calling mobile station alerts a caller to receipt of the confirmation message.

Abstract. The Examiner relies on the following prior art references to show unpatentability:

DeGiorgio	US 3,866,206	Feb. 11, 1975
Itoh	US 5,280,521	Jan. 18, 1994
John	US 6,216,106 B1	Apr. 10, 2001 (filed Dec. 15, 1998)
Choksi	US 6,477,243 B1	Nov. 5, 2002 (filed Apr. 29, 1998)

Claims 21-25 stand rejected under 35 U.S.C. § 103(a) as obvious over John in view of Itoh.

Claim 16-19 and 27 stand rejected under 35 U.S.C. § 103(a) as obvious over John in view of Itoh and Choksi.

Claim 20 stands rejected under 35 U.S.C. § 103(a) as obvious over John in view of Itoh, Choksi, and DeGiorgio.

Claim 26 stands rejected under 35 U.S.C. § 103(a) as obvious over John in view of Itoh and DeGiorgio.

PRINCIPLES OF LAW

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *See In re Royka*, 490 F.2d 981, 985 (CCPA 1974). In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). If the Examiner's burden is met, the burden then shifts to Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

CLAIMS 21-26

Representative claim 21¹ reads as follows:

21. A method of communicating a confirmation message, comprising the steps of:

determining, when a voice call is not normally established between a called mobile station and a calling mobile station, if a called party of the

¹ Appellant argues claims 16-20 together as one group and claims 21-27 together as a second group. *See App. Br. 2*. For the reasons set forth below, we select independent claim 16 as representative of claims 16-20; we select independent claims 21 as representative of claims 21-26, as rejected; and we address claim 27 separately. *See 37 C.F.R. § 41.37(c)(1)(vii)*.

called mobile station has confirmed a message created and transmitted by the calling mobile station;

generating, by the called mobile station, a confirmation message indicating the confirmation by the called party; and

transmitting, from the called mobile station, the confirmation message to the calling mobile station.

Arguments and Issue

The Examiner concludes that John discloses the following steps: (1) determining, when a voice call is not normally established between a called mobile station (MS) and a calling MS, if a called party of the called MS has confirmed a message created and transmitted by the calling MS; (2) generating a confirmation message indicating the confirmation; and (3) transmitting the confirmation message to the calling MS. Ans. 3-4.² The Examiner further concludes that Itoh teaches the missing claim requirements of such a confirmation message being generated by the called party and being transmitted from the called MS to the calling MS. Ans. 4.

Appellant contends, *inter alia*, that the combination of John and Itoh does not teach the claimed “step of generating and transmitting, by the called mobile station, a confirmation message indicating the confirmation by the called party.” App. Br. 7.

More specifically, Itoh, [sic] discloses that if a called terminal receives a message from a calling terminal, the called terminal transmits an answering signal without regard to if a

² Rather than repeat the arguments of Appellant or the Examiner, we refer to the Appeal Brief (filed May 24, 2007); the Examiner’s Answer (filed Sep. 13, 2007); and the Reply Brief (filed Nov. 13, 2007) for their respective details. In this decision, we have considered only those arguments actually made by Appellant. Arguments which Appellant could have made but did not make in the Briefs have not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii).

called party confirms a message or not to enable the calling terminal to check if the called terminal correctly received the message. That is, the calling terminal cannot check if the called party has confirmed the message, but can only check that the message is received in the called terminal.

Id.

The issue before us, then, is: Has Appellant shown that the Examiner erred in finding that Itoh discloses a called mobile station generating and sending a confirmation message indicating a confirmation by the called party?

Finding of Fact

The record supports the following Finding of Fact (FF) by a preponderance of the evidence:

1. Itoh discloses:

A message to a mobile station is sent to a base station via a digital exchange of a fixed communication network and is transmitted as a packet from the base station. The called mobile station verifies that it has received the message correctly, and then sends an answer signal to the calling party via the base station, and the calling party verifies that the message has reached the called mobile station. The mobile station stores the message and indicates its reception to the calling party. The called party reads out the stored message.

Col. 4, l. 67 – col. 5, l. 8.

Analysis

The Examiner acknowledges that John does not disclose a called party confirming receipt of a message, but rather relies upon Itoh for this teaching. Ans. 4, 8-10. However, the sole passage of Itoh upon which the Examiner relies for this teaching (*id.*) does not teach that the called party confirms

receipt of the message. Rather, Itoh merely teaches a called MS sends confirmation that a message has been received. *See* FF 1.

For the foregoing reasons, Appellant has persuaded us of error in the Examiner's obviousness rejection of representative claim 21. Accordingly, we will not sustain the Examiner's rejection of that claim or the Examiner's rejection of claims 22-25, which depend therefrom.

With respect to the remaining rejection of dependent claim 26, DeGiorgio does not cure the deficiency of the obviousness rejection explained above. Accordingly, we do not sustain the Examiner's rejection of claim 26.

CLAIMS 16-20

Representative claim 16 is reproduced below with emphasis added to the relevant language:

16. A method of communicating a confirmation message, comprising the steps of:

informing a called mobile station of receipt of a message from a calling mobile station;

determining, if the received message is a *text message*, if a called party of the called mobile station has confirmed the received message, which is stored in the called mobile station; and

transmitting, from the called mobile station, a confirmation message to be delivered to the calling mobile station, *wherein* the confirmation message is generated by the called mobile station when the called mobile station has confirmed the received message and *the confirmation message includes a telephone number of the calling mobile station.*

Arguments and Issue

Independent claim 16 differs from independent claim 21 in various aspects, including the following two. First, claim 16 is directed towards a

method of a called party confirming receipt of a text—as opposed to a voice—message. Second, claim 16 further requires that “the confirmation message includes a telephone number of the calling mobile station.”

Similar to the position set forth in the rejection of claim 21, the Examiner relies upon John for disclosing the steps of (1) determining whether a called party has received a text message; and (2) transmitting confirmation to the calling party that the text message has been received by the called party. Ans. 5. The Examiner again finds that Itoh teaches the missing claim requirements of such a confirmation message being generated by the called party and being transmitted from the called MS to the calling MS. *Id.* The Examiner further finds that Choksi teaches the additional requirement that the confirmation message includes a telephone number of the calling MS. Ans. 6.

Appellant makes arguments for claim 16 that are similar to those noted above: the combination of John and Itoh does not teach the claimed “step of generating and transmitting, by the called mobile station, a confirmation message indicating the confirmation by the called party.” App. Br. 5. But rather, Itoh merely discloses sending confirmation of receipt of a message. *Id.* Appellant further contends that Choksi does not cure the deficiency because it “deals with a receipt notification containing a telephone number, and not if a calling terminal can check if the called party has confirmed the message.” *Id.*

Appellant additionally argues that even if the cited references were to be combined, they would not produce a system wherein “a confirmation message is *directly* transmitted to the calling party,” without the need “to

store the confirmation message in a separate server.” App. Br. 6 (emphasis added). Rather:

when a called terminal confirms a message [in the cited prior art], a confirmation message is generated and stored in a server, not directly transmitted to a calling terminal. . . . [T]he calling terminal must then transmit a request for message confirmation in order to receive the message confirmation of the called terminal from the server.

App. Br. 5-6.

The second issue before us, then, is: Has Appellant shown that the Examiner erred in finding that John, Itoh, and Choksi collectively teach a method of communicating a confirmation message wherein, when a called party confirms the receipt of a message, the called mobile station generates a confirmation message to be delivered to the calling mobile station?

Additional Findings of Fact

Choksi

2. Integration of telecommunication message services and other communication services is achieved by notifying a user of a communication system of successful receipt of a message (e.g., a facsimile message) by sending a confirmation message to the user, e.g., using e-mail, facsimile, voice and/or data communications. The user may be identified by a unique identifier, e.g., a telephone number. . . . The information may allow the user to view the message (e.g., as marked up by the intended recipient thereof), and/or it may indicate whether the intended recipient has read, reviewed, down-loaded to a hard copy or other device or otherwise accessed the message.

Abstract.

3. Upon transmission of the notification message, the user (i.e., associated with the transmitting facsimile machine 14) may receive a confirmation message indicating that facsimile message 12 was successfully received by computer 18 and that the intended recipient of the message has been notified thereof.

Alternatively, or in addition, the user may receive such a confirmation message after the intended recipient has actually read, reviewed or otherwise accessed or received the facsimile message (e.g., by accessing a web site at which the message is available for review as described in the above-identified co-pending application). In still further embodiments, the intended recipient of the facsimile message may choose to have a confirmation message transmitted to the user. For example, if after the intended recipient has accessed the facsimile message by visiting a web page as discussed above, the user may notify computer 18 (or another server where the web page is stored) of successful reception of the facsimile message and request that a confirmation message be transmitted to the user. This may be accomplished by specifying a communication address (e.g., an e-mail, pager, telephone, etc. address or number) that the confirmation address should be transmitted to, for example, by submitting a web form including the communication address, or in some embodiments by simply having the intended recipient transmit an electronic message (e.g., by clicking on a "send confirmation" button displayed on the web page, instructing computer 18 to send the confirmation message.

Col. 6, ll. 1-28.

4. [A]n automated facsimile message system has been described. Although the present invention has been discussed with reference to specific illustrated embodiments thereof, the generality of the present invention should in no way be limited thereby. For example, in addition to the above-described embodiments, a subscriber-based telecommunications message (e.g., voice or data) system configured in accordance with the present invention may include a message reception station configured to receive voice and/or data messages for a number of subscribers and to notify each sender thereof of the successful receipt and or [sic] review of a message. The system may also include an interface for coupling the message reception station to a computer network, e.g., the internet. In general, the message reception station may include a mapping function (e.g., as embodied in a look-up table) configured to provide a communication address for one of the system users in

response to a[n] indication that a message transmitted by that user has been received and/or reviewed. Such indication may be provided by a unique identifier associated with the user. The unique identifier may be received automatically (e.g., as an ANI) or as additional user input and, preferably, comprises a series of digits such as a telephone number associated with the message source.

Col. 9, ll. 30-53.

5. “[T]he confirmation message may be down-loaded as a voice message (e.g., a computer-synthesized voice message) to telephone/cellular telephone 29.” Col. 6, ll. 48-51.

Analysis

“Before considering the rejections . . . , we must first [determine the scope of] the claims” *In re Geerdes*, 491 F.2d 1260, 1262 (CCPA 1974). We therefore first address the meaning and scope of the limitation of claim 16 (emphasis added): “transmitting, from the called mobile station, a confirmation message *to be delivered* to the calling mobile station”

We find that the scope of claim 16 is broader than if the claim had omitted the language “to be delivered” and alternatively recited “transmitting a confirmation message to the calling mobile station.” By reciting “to be delivered,” claim 16 sets forth the intended purpose of transmitting a confirmation message from a called MS, but it does not actually require the delivery of the confirmation to the calling MS. That is, claim 16 merely requires that a confirmation message be transmitted from the called MS to any destination and that the message be of a form that is capable of being subsequently delivered to the calling MS.

Moreover, even if the claim language “to be delivered” is ignored and the limitation is alternatively interpreted as reciting “transmitting a

confirmation message to the calling mobile station,” the claim would still read on a method of communicating a confirmation message from a called MS to a calling MS where the message is first transmitted to, and temporarily stored on, a separate server. By not narrowing the language to specifically recite, “transmitting a confirmation message *directly* to the calling mobile station,” the limitation is broad enough to also read on transmitting a confirmation message *indirectly* to the calling MS. During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

We recognize that Appellant’s Specification only discloses a communication method wherein a confirmation message from a called MS is transmitted *directly* to the calling MS. *See* Spec. 4-12. However, it is well-settled that although the claims are interpreted in light of the Specification, limitations from the Specification are not read into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). Accordingly, Appellant’s argument that claim 16 requires that a message be transmitted directly from the called MS to the calling MS (App. Br. 5-6) is not persuasive.

Turning to the cited prior art, Choksi discloses a method of communicating confirmation of receipt of a message to a calling party. FF 2. A confirmation message may be sent to the originator of the message “after the intended recipient has actually read, reviewed or otherwise accessed or received the . . . message.” FF 3. Alternatively, the intended recipient of the message may choose whether to transmit a confirmation message to the originator of the message. *Id.* Moreover, while Choksi is primarily directed towards sending a confirmation in response to receipt of

fax messages (*see, e.g., id.*), Choksi's method also applies to a recipient sending confirmation messages in response to receipt of voice and data (or text) messages. FF 4. The confirmation message may include a telephone number of the message source, or calling phone. *Id.* The confirmation message may be downloaded to a cellular telephone. FF 5.

Restated, Choksi alone discloses each and every limitation of claim 16. As such, Appellant has not shown that the Examiner erred in finding that John, Itoh, and Choksi collectively teach a method of communicating a confirmation message wherein, when a called party confirms the receipt of a message, the called MS generates a confirmation message to be delivered to the calling MS. *See In re Meyer*, 599 F.2d 1026, 1031 (CCPA 1979) (noting that obviousness rejections can be based on references that happen to anticipate the claimed subject matter). Accordingly, we will sustain the Examiner's rejection of claim 16 and dependent claims 17-20, which fall with claim 16.

CLAIMS 21 AND 27

Claim 27 depends from independent claim 21 and further recites "wherein the confirmation message includes a telephone number of the calling mobile station." As noted above, we do not sustain the Examiner's rejection of claim 21 based upon only John and Itoh. However, like claims 16-20, the Examiner rejected dependent claim 27 based upon further combining Choksi with John and Itoh. We will therefore sustain the Examiner's rejection of dependent claim 27.

Claim 27, based upon its dependence from claim 21, requires "transmitting, from the called mobile station, the confirmation message to

the calling mobile station.” Just as in the case of claim 16, though, claim 27 does not require transmitting the confirmation message from the called MS *directly* to the calling MS. Rather, claim 27 is broad enough to read on transmitting the message indirectly to the calling MS. For the reasons set forth in relation to claims 16-20, then, we also find that Choksi alone discloses each and every limitation of claim 27. As such, Appellant has not shown that the Examiner erred in finding that John, Itoh, and Choksi collectively teach a method of communicating a confirmation message after determining a called party has confirmed receipt of a voice message, as required by dependent claim 27. *See Meyer*, 599 F.2d at 1031 (noting that obviousness rejections can be based on references that happen to anticipate the claimed subject matter).

Independent claim 21 does not include the additional limitation recited in dependent claim 27 and is therefore broader than claim 27. Pursuant to our authority under 37 C.F.R. § 41.50(b), then, we enter a new ground of rejection for claim 21 under 35 U.S.C. § 103(a) as obvious over John in view of Itoh and Choksi. *See Ormco Corp. v. Align Tech., Inc.*, 498 F.3d 1307, 1319 (Fed. Cir. 2007) (holding that where dependent claims “were found to have been obvious, the broader [independent claims] must also have been obvious”).

DEPENDENT CLAIMS 22-26

The Board of Patent Appeals and Interferences is a review body, rather than a place of initial examination. We have rejected independent claim 21 under 37 C.F.R. § 41.50(b). However, we have not reviewed the remaining claims 22-26 to the extent necessary to determine whether these

claims are also unpatentable under 35 U.S.C. § 103. We leave it to the Examiner to determine the appropriateness of any further rejections based thereon.

CONCLUSIONS OF LAW

Appellant has shown that the Examiner erred in finding that Itoh discloses a called MS generating and sending a confirmation message indicating a confirmation by the called party. As such, Appellant has shown that the Examiner erred in rejecting claims 21-26 under 35 U.S.C. § 103.

Appellant has not shown that the Examiner erred in finding that John, Itoh, and Choksi collectively teach a method of communicating a confirmation message wherein, when a called party confirms the receipt of a message, the called MS generates a confirmation message to be delivered to the calling MS. As such, Appellant has not shown that the Examiner erred in rejecting claims 16-20 and 27 under 35 U.S.C. § 103.

We further conclude that John in view of Itoh and Choksi renders claim 21 obvious under 35 U.S.C. § 103.

DECISION

We do not sustain the Examiner's rejections with respect to appealed claims 21-26. Therefore, the Examiner's decision rejecting claims 21-26 is reversed.

We sustain the Examiner's rejections with respect to appealed claims 16-20 and 27. Therefore, the Examiner's decision rejecting claims 16-20 and 27 is affirmed.

Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter a new ground of rejection for claim 21 under 35 U.S.C. § 103(a) as obvious over John in view of Itoh and Choksi.

FINALITY OF DECISION

Regarding the affirmed rejections, 37 C.F.R. § 41.52(a)(1) provides that “Appellant may file a single request for rehearing within two months of the date of the original decision of the Board.”

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (2007). This regulation states that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Furthermore, 37 C.F.R. § 41.50(b) also provides that Appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

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If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment, or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART
37 C.F.R. § 41.50(b)

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